

REMARKS

Claims 1-52 are pending in this application.

Claims 1 and 27 are independent.

Claims 1-52 stand rejected under 35 USC §103(a), as obvious over Thomas et al. (U.S. Patent No. 6,173,272). The rejection is respectfully traversed.

Prior to discussing the features which distinguish the present invention over the applied prior art, it is perhaps first worthwhile to point out that in rejecting claims under 35 U.S.C. §103(a), it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. In so doing, the Examiner is required to make the factual determination set forth in Graham v. John Deere Co. of Kansas City (148 USPQ 459 (1966)), and to provide a reason why one having ordinary skill in the art would have been led to modify the prior art to arrive at the claimed invention.

Such reason must stem from some teaching, suggestion or inference in the prior art as a whole. It is imperative for the decision maker to place himself back in time to when the invention was unknown, i.e., without the Applicants' disclosure at his side, and determine, in light of all the objective evidence bearing on the issue of obviousness, whether one having ordinary skill in the art would have found the claimed invention as a whole obvious.

It should be recognized that the fact that the prior art could be modified so as to result in the combination defined by the claims would not have made the modification obvious unless the prior art suggests the desirability of the modification (See In re Deminski, 230 USPQ 313 (Fed. Circ. 1986)). In determining the issue of obviousness, one must look to the teachings of the reference(s) relied upon and to whether the

hypothetical person of ordinary skill in the art, familiar with such teachings would have found it obvious to make a corresponding structure or process to that being claimed (See In re Fritch (23 USPQ 1780 (Fed. Circ. 1992)).

In determining obviousness, the inquiry is not whether each element existed in the prior art, but whether the prior art made obvious the invention as a whole for which patentability is claimed. Obviousness cannot be properly established by simply showing that each claimed element may be found somewhere in the prior art (See Hartness International, Inc. v Simplimatic Engineering Co. (2 USPQ 2d 1826 (Fed. Circ. 1987)).

Simplicity and hindsight are not proper criteria for resolving obviousness (In re Warner, 154 USPQ 173 (CCPA 1967)). The mere possibility that the prior art could be modified so as to result in the combination defined by the claims does not make the modification obvious. In the absence of a suggestion of the desirability of the modification within the prior art, the basis for the rejection must be viewed as nothing more than a hindsight reconstruction of the present invention using the Applicants' claims as a guide (See In re Deminski *supra*). Stated another way, the fact that the prior art could be modified so as to result in the combination defined by the claims would not have made the modification obvious, unless the prior art suggests the desirability of the modification (See In re Gordon 221 USPQ 1125 (Fed. Circ. 1984), and In re Keller 208 USPQ 817 (CCPA 1981)).

As the Federal Circuit recently reiterated, reliance on common knowledge and/or common sense also cannot be the basis of finding obviousness (See In re Lee 61 USPQ 2d 1430 (Fed. Circ. 2002)). The deficiencies in the applied art cannot be

remedied by general conclusions which, in view of the disclosure in the present application, may appear to be common sensible.

Additionally, MPEP §707.07 clearly requires that "before ... rejection is in order a clear issue should be developed between the Examiner and applicant." Indeed, the Manual states that "the references should be fully applied" (emphasis added), so as to deal justly with the applicant as well as the public. The Manual goes on to state that "present practice does not sanction hasty and ill-considered...rejections". "The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end." "The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible..."(emphasis added).

In relevant part, MPEP § 707.07(g) instructs an Examiner that "[w]here a major technical rejection is proper, it should be stated with a full development of reasons rather than by a mere conclusion coupled with some stereotyped expression" (emphasis added). Omnibus rejections are to be avoided. Hence, a plurality of claims should never be grouped together in a common rejection, unless that rejection is applicable to all the claims in the group. (See MPEP §707.07(d))

It is respectfully submitted that the rejection has been made in omnibus fashion, and hence is improper on its face. Furthermore, the asserted obviousness is unsupported by the required factual determination, and accordingly cannot be reasonably understood. It is also respectfully submitted that there is nothing within the applied art teachings that would suggest the Examiner's proposed modification to arrive at

the invention claimed in the present application. Rather, the applied prior art lacks any teaching or suggestion of the combination recited in each of the independent claims, as well as any suggestion that such combinations of features could or would be beneficial.

Thomas, as for example shown in Figure 2A, lacks multiple payment networks, with each of the networks having a plurality of associated payors and payees. Hence, Thomas has no need to transmit a request to determine which of multiple payment networks is associated with a payee to whom a payor associated with one of the payment networks wishes to direct the payment.

What Thomas discloses in the referenced text in column 4 is that the home banking system transmits a universal identifier for the payee, rather than the payee's name and address, to the trusted third party. The trusted third party then uses the universal identifier to identify the payee and to generate the routing/transit number (RTN) for the payee's account number. In this way, the RTN number of the payee's bank account does not need to be disclosed to the home banking system.

The disclosure relied upon in column 8 relates to details of the universal identifier and the initial generation of the universal identifier for a particular payee. The referenced text in the paragraph bridging columns 3 and 4 sets forth Thomas's objective of utilizing the unique identifier to avoid the disclosure of confidential information. Hence, the disclosure relied upon in support of the obviousness rejection lacks any teaching or suggestion of numerous features recited in each of independent claims 1 and 27, as well as in their dependencies.

Accordingly, it is respectfully requested that the rejection of claims 1-52 be reconsidered and withdrawn.

Claims 1, 5-10, 27 and 31-36 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 53-72 of co-pending U.S. Application S/N 09/984,568. The rejection is respectfully traversed.

As understood, the rejection is based on the conclusion that claims 53-72 recite the same system and method as that of the provisionally rejected claims, and are distinguishable only on the basis of an intended use.

Claim 1, for example, requires the receipt of the request to make a payment and the transmission of a payment instruction from a first payment service provider to a second payment service provider. Claim 53 on the other hand, requires the receipt of a request to receive an electronic bill and the transmission of an activation instruction to a second billing service provider. Hence, these claims respectively recite entirely different limitations and hence, patentably distinct methods.

The Examiner is correct in stating that the intended usages of the inventions are different, i.e. the use of the invention of the '897 application being for bill payment and of the '568 application being for bill presentment. However, this is not all that distinguishes these inventions. In this regard, it is respectfully submitted that there is nothing in claim 1 of the present application which would make obvious the transmission of an activation instruction, as required in claim 53 of the '568 application. Further, the transmission of a payment instruction, as required in claim 1, of the present application is not made obvious by the recitals in claim 53 of the '568 application. Hence, claim 1 of the present application is non-obvious over claim 53 of the '568 application.

As the basis for the obviousness-type double patenting rejection has not been argued on a claim-by-claim basis, other features which distinguish claims 5-10, 27 and

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31-36 are not individually discussed herein.

Accordingly, it is respectfully requested that the provisional obviousness-type double patenting rejection be reconsidered and withdrawn.

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed local telephone number, in order to expedite resolution of any remaining issues and further to expedite passage of the application to issue, if any further comments, questions or suggestions arise in connection with the application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 01-2135 and please credit any excess fees to such deposit account.

Respectfully submitted,
ANTONELLI, TERRY, STOUT & KRAUS, LLP



Alfred A. Stadnicki
Registration No. 30,226

AAS/led
1300 N. 17th Street
Suite 1800
Arlington, Virginia 22209
Telephone: 703-236-6080
Facsimile: 202-296-1682
DATE: March 20, 2003



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